

## ADMINISTRATIVE PANEL DECISION

C F E B SISLEY v. Finlay Rahman, Aidan Powell, Leah Ford, Owen Fry, Alice Reeves

Case No. D2024-1649

### 1. The Parties

The Complainant is C F E B SISLEY, France, represented by Fidal, France.

The Respondents are Finlay Rahman, Aidan Powell, Leah Ford, Owen Fry and Alice Reeves, Italy.

### 2. The Domain Names and Registrar

The disputed domain names, <sisleyargentina.com>, <sisleyaustralia.com>, <sisleybelgie.com>, <sisleybelgique.com>, <sisleybrasil.com>, <sisleybulgaria.com>, <sisleycanada.com>, <sisleychile.com>, <sisleycolombia.com>, <sisleycz.com>, <sisleydanmark.com>, <sisleydeutschland.com>, <sisleyeesti.com>, <sisleyfrance.com>, <sisleygreece.com>, <sisleyhrvatska.com>, <sisleyireland.com>, <sisleyisrael.com>, <sisleyitalia.com>, <sisleyjapan.net>, <sisleykuwait.com>, <sisleylatvija.com>, <sisleylietuva.com>, <sisleymexico.com>, <sisleynederland.com>, <sisleynorge.com>, <sisleynz.com>, <sisleyperu.com>, <sisleypolska.com>, <sisleyportugal.com>, <sisleyromania.com>, <sisleyschweiz.com>, <sisleyslovenija.com>, <sisleyslovensko.com>, <sisleysouthafrica.com>, <sisleysrbija.com>, <sisleysuisse.com>, <sisleysuomi.com>, <sisleysverige.com>, <sisleyuae.com>, <sisleyuk.net>, and <sisleyuruguay.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2024. On April 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 22, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (No information) and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 23, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on April 26, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents of the Complaint, and the proceedings commenced on April 30, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 20, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on May 21, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on May 28, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is a company incorporated under the laws of France since 1972; it manufactures and worldwide distributes high end cosmetics, perfumes and hair products under the mark SISLEY (Annex 1 and 2 to the Complaint).

The Complainant owns various trademark registrations containing the mark SISLEY around the world, inter alia:

- French trademark (word), Registration No. 1199308, registered on March 23, 1982;
- International trademark (word), Registration No. 385946, registered on February 10, 1972, designating for e.g., Germany, Benelux, Bulgaria, Croatia, Italy, Japan;
- International trademark (word) Registration No. 497472, registered on October 23, 1985, designating for e.g., Denmark, Italy, Portugal, Romania, United Kingdom, Switzerland, Czech Republic, Slovakia, Sweden (Annex 9 to the Complaint).

Moreover, the Complainant has registered several domain names containing the mark SISLEY, e.g., <sisley.fr>, <sisley.eu>, <sisley.info> or <sisley.in>; all of these domain names refer to the Complainant's official website under <sisley-paris.com> (Annex 10 to the Complaint).

The Respondents have registered the disputed domain names on August 22, 2023, with ALIBABA.com (Annex 3 to the Complaint). At the time of filing the Complaint, the disputed domain names referred to websites which were very similar to the Complainant's official website under <sisley-paris.com> and where products of the Complainant were offered for sale together with photographs of the Complainant's products and the Complainant's mark SISLEY (Annex 5, 6, 13 to the Complaint).

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that SISLEY is a famous and globally well-known trademark; the disputed domain names entirely incorporate this famous trademark. The Complainant submits that the Respondents were aware of the Complainant's trademark when registering the disputed domain names and the disputed domain names resolved to websites which are similar to the Complainant's official website

under <sisley-paris.com> purporting to offer for sale many cosmetics products, skincare and perfumes that are counterfeits, or at least unauthorized; such goods are being offered disproportionately below market value.

In doing so, the Respondent used the disputed domain names to prominently display and reproduce (without authorization) the Complainant's registered trademark SISLEY.

There is no legal relationship whatsoever between the Complainant and the Respondents.

## **B. Respondent**

The Respondents did not reply to the Complainant's contentions.

## **6. Preliminary Procedural Issue: Consolidation of Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that:

- the disputed domain names were registered on the same day within seven minutes and the underlying registrant details for the disputed domain names mention the same country (Italy) and the Registrar is for all disputed domain names ALIBABA.com (Annex 3 to the Complaint);
- the disputed domain names have a very similar naming pattern: the Complainant's registered trademark SISLEY plus a geographic element and the generic Top-Level-Domains ".com" or ".net";
- the disputed domain names target the Complainant in a very similar manner by resolving to websites which offer the Complainant's products for sale together with photographs of the Complainant's products and its registered trademark SISLEY; and
- the Respondents did not react in any way – the Respondents neither rejected the consolidation request nor filed any Response.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

## 7. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

### A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the mark SISLEY for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

In the present case, the disputed domain names are confusingly similar to the SISLEY mark in which the Complainant has rights since they incorporate the entirety of the mark SIISLEY and only add geographic terms – either the name of a country in English or a translation in another language or an ISO country code.

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain names, the mere addition of other terms does not prevent a finding of confusing similarity under the first element of the Policy ([WIPO Overview 3.0](#), section 1.8). This is the case at present – the SISLEY trademark clearly remains recognizable in each of the disputed domain names.

Finally, it has also long been held that generic Top-level Domains (“gTLDs”) (in this case “.com” or “.net”) are generally disregarded when evaluating the confusing similarity of a disputed domain name. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names, since it has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the SISLEY trademark in any manner.

The Respondent is not an authorized dealer of the Complainant's products. The disputed domain names resolved to a website which displayed prominently the Complainant's trademark together with photographs of the Complainant's products, and the Respondent offered the Complainant's products for sale.

As outlined in the “Oki Data test”, for showing a right or legitimate interest the respondent must at least accurately and prominently disclose its relationship with the trademark holder. The Panel notes, that the Respondent’s use of the disputed domain names fails to meet this essential transparency criteria.

Furthermore, the nature of the disputed domain names, comprising the Complainant’s mark in its entirety together with geographic terms and the similar naming pattern of the disputed domain names cannot be considered fair as these falsely suggest an affiliation with the Complainant and its products that does not exist. [WIPO Overview 3.0](#), section 2.5.

The Respondent did not reply and hence has not rebutted the Complainant’s contentions.

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

As stated in many decisions rendered under the Policy both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain names were registered by the Respondent in bad faith; and
- the disputed domain names were being used by the Respondent in bad faith.

(i) The Complainant has established rights in the registered trademark SISLEY, long before the registration of the disputed domain names. Further, the trademark SISLEY is distinctive and well known.

Hence, it is inconceivable for this Panel that the Respondent has registered and used the disputed domain names without knowledge of the Complainant’s rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain names entirely incorporate the Complainant’s distinctive and registered trademark SISLEY together with general geographic terms and all disputed domain names have a very similar naming pattern; these aspects strengthen the impression that the Respondent was aware of the Complainant and its SISLEY mark at the time of registration of the disputed domain names. Furthermore, the fact that the Respondent registered the disputed domain names almost simultaneously (within seven minutes) is a strong indication of bad faith registration in the present case.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) The Complainant put forward evidence that the disputed domain names resolved to websites where the Complainant’s products were offered for sale and which prominently displayed the Complainant’s SISLEY trademark and photographs of the Complainant’s products. In doing so, the Respondent has attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of its website according to paragraph 4(b)(iv) of the Policy which constitutes bad faith registration and use of the disputed domain names.

Moreover, the Respondent’s websites, addressed by the disputed domain names, are very similar to the Complainant’s official website under <sisley-paris.com> and hence lure unsuspecting Internet users to pass Respondent’s websites off as the Complainant’s website and thereby profit from the Complainant’s marks – this also constitutes bad faith under paragraph 4(b)(iv) of the Policy.

The evidence and documents produced and put forward by the Complainant together with the fact that the Respondent has failed to present any evidence of any good faith registration and use with regard to the disputed domain names further supports the finding of bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## 8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names, <sisleyargentina.com>, <sisleyaustralia.com>, <sisleybelgie.com>, <sisleybelgique.com>, <sisleybrasil.com>, <sisleybulgaria.com>, <sisleycanada.com>, <sisleychile.com>, <sisleycolombia.com>, <sisleycz.com>, <sisleydanmark.com>, <sisleydeutschland.com>, <sisleyeesti.com>, <sisleyfrance.com>, <sisleygreece.com>, <sisleyhrvatska.com>, <sisleyireland.com>, <sisleyisrael.com>, <sisleyitalia.com>, <sisleyjapan.net>, <sisleykuwait.com>, <sisleylatvija.com>, <sisleylietuva.com>, <sisleymexico.com>, <sisleynederland.com>, <sisleynorge.com>, <sisleynz.com>, <sisleyperu.com>, <sisleypolska.com>, <sisleyportugal.com>, <sisleyromania.com>, <sisleyschweiz.com>, <sisleyslovenija.com>, <sisleyslovensko.com>, <sisleysouthafrica.com>, <sisleysrbija.com>, <sisleysuisse.com>, <sisleysuomi.com>, <sisleysverige.com>, <sisleyuae.com>, <sisleyuk.net>, and <sisleyuruguay.com>, be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: June 11, 2024